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22428	7590	06/30/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/025,770		OSHIBA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	John Van Bramer		3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on April 4, 2006, cancelled no claims. No new claims were added and Claims 1, 12, 23, 34, and 38-40<sup>WERE AMENDED</sup>. Thus the currently pending claims are 1 - 40

### *Claim Objections*

2. The amendment filed on April 4, 2006 corrected the objections to Claims 1, 12, and 23 raised in the Office Action dated January 4, 2006. Therefore, the examiner hereby withdraws the objections.

### **Claim Rejections - 35 USC § 112**

3. The amendment filed on April 4, 2006 affirmed the examiners interpretation of Claims 8, 9, 19, 20, 30, 31, and 36 and the limitations imposed therefrom, which were presented on Page 3 of the Office Action dated January 4, 2006. The applicant's representative added the additional limitation that the first one of the multiple advertisements may be subject to competition. Therefore, the examiner withdraws the 35 USC 112 rejection raised in the Office Action dated January 4, 2006. Thus Claims 8, 9, 19, 20, 30, 31 and 36 are subject to the following interpretation.

- a. There is more than one advertisement that will be displayed on a single advertisement opportunity.
- b. The bidding for one of the available advertisement spots, within the single advertisement opportunity, has already completed.
- c. As bids proceed for the other available advertisement spots, within the single advertisement opportunity, the competition check is used to ensure that competitors in the same business category will not be displayed on the same advertisement opportunity.
- d. The first one of the multiple advertisements may be subject to competition.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7, 10-18, 21-29, 32-35, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Roth et al (WO 98/34189).

Claim 1: Roth discloses an advertisement opportunity trading system enables communication between a terminal of a sponsor of an advertisement and a terminal of media which distributes an advertisement via a communication network, in order

to intermediate between the sponsor and the media for facilitating a trade for an advertisement opportunity offered by the media, said system comprising:

- a. An advertisement data reception unit, which receives advertisement data from a sponsor who wants the advertisement data to be distributed on an advertisement opportunity; an advertisement opportunity reception unit, which receives an advertisement opportunity offered by media. (Page 6, line 17 through Page 7, line 15)
- b. A distribution accepting unit which receives information, from the media representing that distribution of the advertisement data is appropriate/inappropriate when the sponsor selects the advertisement opportunity received by said advertisement opportunity reception unit for distributing the advertisement data received by said advertisement data reception unit, for accepting an application for distribution of the advertisement data from the sponsor only after it is determined that the information from the media represents that distribution is appropriate. (Page 6, line 17 through Page 7, line 15)
- c. A trade process unit, which performs a process for trading the advertisement opportunity based on the application accepted by said distribution accepting unit. (Page 6, line 17 through Page 7, line 15)

Claim 2: Roth discloses the advertisement opportunity trading system according to claim 1, wherein in a case where said distribution accepting unit accepts applications

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for distribution of advertisement data from a plurality of sponsors for a same advertisement opportunity, said trade process unit puts up the advertisement opportunity for auction. (Page 6, line 17 through Page 7, line 15)

Claim 3: Roth discloses the advertisement opportunity trading system according to claim 1, further comprising:

- a. An advertisement data registration unit, which registers the advertisement data received by said advertisement data reception unit. (Page 6, line 17 through Page 7, line 15)
- b. An advertisement opportunity registration unit, which registers the advertisement opportunity received by said advertisement opportunity reception unit. (Page 6, line 17 through Page 7, line 15)
- c. An advertisement opportunity publicizing unit which publicizes information on the advertisement opportunity registered in said advertisement opportunity registration unit via said communication network, wherein said distribution accepting unit accepts an application for distribution of the advertisement data registered in said advertisement data registration unit from the sponsor. (Page 6, line 17 through Page 7, line 15)

Claim 4: Roth discloses the advertisement opportunity trading system according to claim 3, wherein:

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- a. A plurality of advertisement data can be registered by a sponsor in said advertisement data registration unit for one advertisement opportunity. (Page 23, line 8 through Page 24, line 1)
- b. In a case where the media determines that the plurality of advertisement data of the sponsor are appropriate for distribution on the one advertisement opportunity, said distribution accepting unit accepts an application for distribution of one advertisement data designated by the sponsor from the plurality of advertisement data, as one to be actually distributed. (Page 23, line 8 through Page 24, line 1)

Claim 5: Roth discloses the advertisement opportunity trading system according to claim 4, wherein said advertisement data reception unit changes the advertisement data designated by the sponsor as one to be actually distributed with another advertisement data among the plurality of advertisement data in accordance with an instruction from the sponsor. (Page 26, line 6 through Page 27, line 2)

Claim 6: Roth discloses the advertisement opportunity trading system according to claim 1 wherein:

- a. Said advertisement data reception unit receives a genre of the advertisement data. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26) (The Merriam-Webster dictionary defines genre as a "kind, or sort" in relation to a particular style, form or content. In the section cited Roth discloses the ability of

- a site to define the type of advertising content that it is willing to accept, such as, java, gif, or file size)
- b. Said advertisement opportunity reception unit receives a prohibited genre for designating a genre which will not be distributed on the advertisement opportunity. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- c. Said system further comprises an advertisement data check unit which checks whether the genre of the advertisement data distribution of which on the advertisement opportunity the sponsor applies for corresponds to the prohibited genre or not, and notifies a result of checking to the media. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)

Claim 7: Roth discloses the advertisement opportunity trading system according to claim 3, wherein:

- a. Said advertisement data registration unit registers a genre of the advertisement data. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- b. Said advertisement opportunity registration unit registers a prohibited genre for designating a genre which will not be distributed on the advertisement opportunity. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- c. Said system further comprises are advertisement data check unit which checks whether the genre of the advertisement data distribution of which on the advertisement opportunity the sponsor applies for corresponds to the prohibited



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genre or not, and notifies a result of checking to the media. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)

Claim 10: Roth discloses the advertisement opportunity trading system according to claim 1, further comprising an advertisement data mirroring unit which transmits advertisement data which is determined as appropriate for distribution by the media to an advertisement distribution controller which performs distribution of advertisement data, wherein:

- a. Said advertisement data mirroring unit transmits the advertisement data to said advertisement (distribution controller before a trade for an advertisement opportunity is started by said trade process unit. (Page 23, line 8 through Page 24, line 1)
- b. Said advertisement distribution controller stores the transmitted advertisement data, and performs distribution of the stored advertisement data, which is to be distributed on an advertisement opportunity, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 11: Roth discloses the advertisement opportunity trading system according to claim 3, further comprising an advertisement data mirroring unit which transmits advertisement data which is determined as appropriate for distribution by the media to an advertisement distribution controller which performs distribution of advertisement data, wherein:

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- a. Said advertisement data mirroring unit transmits the advertisement data to said advertisement distribution controller before a trade for an advertisement opportunity is started by said trade process unit. (Page 23, line 8 through Page 24, line 1)
- b. Said advertisement distribution controller stores the transmitted advertisement data, and performs distribution of the stored advertisement data, which is to be distributed on an advertisement opportunity, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 12: Roth discloses a market control server which is a server apparatus which enables communication between a terminal of a sponsor of an advertisement and a terminal of media which distributes an advertisement via a communication network, in order to intermediate between the sponsor and the media for facilitating a trade for an advertisement opportunity offered by the media, said server comprising:

- a. An advertisement data reception unit, which receives advertisement data from a sponsor who wants the advertisement data to be distributed on an advertisement opportunity. (Page 6, line 17 through Page 7, line 15)
- b. An advertisement opportunity reception unit, which receives an advertisement opportunity offered by media. (Page 6, line 17 through Page 7, line 15)
- c. A distribution accepting unit which receives information from the media representing that distribution of the advertisement data is

appropriate/inappropriate from the media when the sponsor selects the advertisement opportunity received by said advertisement opportunity reception unit for distributing the advertisement data received by said advertisement data reception unit, for accepting an application for distribution of the advertisement data from the sponsor only after it is determined that the information from the media represents that distribution is appropriate. (Page 6, line 17 through Page 7, line 15)

- d. A trade process unit which performs a process for trading the advertisement opportunity based on the application accepted by said distribution accepting unit. (Page 6, line 17 through Page 7, line 15)

Claim 13: Roth discloses the market control server according to claim 12, wherein in a case where said distribution accepting unit accepts applications for distribution of advertisement data from a plurality of sponsors for a same advertisement opportunity, said trade process unit puts up the advertisement opportunity for auction. (Page 6, line 17 through Page 7, line 15)

Claim 14: Roth discloses the market control server according to claim 12, further comprising:

- a. An advertisement data registration unit, which registers the advertisement data received by said advertisement data reception unit. (Page 6, line 17 through Page 7, line 15)

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- b. An advertisement opportunity registration unit, which registers the advertisement opportunity received by said advertisement opportunity reception unit. (Page 6, line 17 through Page 7, line 15)
- c. An advertisement opportunity publicizing unit which publicizes information on the advertisement opportunity registered in said advertisement opportunity registration unit via said communication network, wherein said distribution accepting unit accepts an application for distribution of the advertisement data registered in said advertisement data registration unit from the sponsor. (Page 6, line 17 through Page 7, line 15)

Claim 15:        Roth discloses the market control server according to claim 14, wherein:

- a. A plurality of advertisement data can be registered by a sponsor in said advertisement data registration unit for one advertisement opportunity. (Page 23, line 8 through Page 24, line 1)
- b. In a case where the media determines that the plurality of advertisement data of the sponsor are appropriate for distribution on the one advertisement opportunity, said distribution accepting unit accepts an application for distribution of one advertisement data designated by the sponsor from the plurality of advertisement data, as one to be actually distributed. (Page 23, line 8 through Page 24, line 1)

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Claim 16: Roth discloses the market control server according to claim 15, wherein said advertisement data reception unit changes the advertisement data designated by the sponsor as one to be actually distributed with another advertisement data among the plurality of advertisement data in accordance with an instruction from the sponsor. (Page 26, line 6 through Page 27, line 2)

Claim 17: Roth discloses the market control server according to claim 12, wherein:

- a. Said advertisement data reception unit receives a genre of the advertisement data. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- b. Said advertisement opportunity reception unit receives a prohibited genre for designating a genre which will not be distributed on the advertisement opportunity. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- c. Said server further comprises an advertisement data check unit which checks whether the genre of the advertisement data distribution of which on the advertisement opportunity the sponsor applies for corresponds to the prohibited genre or not, and notifies a result of checking to the media. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)

Claim 18: Roth discloses the market control server according to claim 14, wherein:

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- a. Said advertisement data registration unit registers a genre of the advertisement data. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- b. Said advertisement opportunity registration unit registers a prohibited genre for designating a genre which will not be distributed on the advertisement opportunity. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- c. Said system further comprises an advertisement data check unit which checks whether the genre of the advertisement data distribution of which on the advertisement opportunity the sponsor applies for corresponds to the prohibited genre or not, and notifies a result of checking to the media. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)

Claim 21: Roth discloses the market control server according to claim 12, further comprising an advertisement data mirroring unit which transmits advertisement data which is determined as appropriate for distribution by the media to an advertisement distribution controller which performs distribution of advertisement data, wherein:

- a. Said advertisement data mirroring unit transmits the advertisement data to said advertisement distribution controller before a trade for an advertisement opportunity is started by said trade process unit. (Page 23, line 8 through Page 24, line 1)
- b. Said advertisement distribution controller stores the transmitted advertisement data, and performs distribution of the stored advertisement data, which is to be

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distributed on an advertisement opportunity, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 22: Roth discloses the market control server according to claim 14, further comprising an advertisement data mirroring unit which transmits advertisement data which is determined as appropriate for distribution by the media to an advertisement distribution controller which performs distribution of advertisement data, wherein:

- a. Said advertisement data mirroring unit transmits the advertisement data to said advertisement distribution controller before a trade for an advertisement opportunity is started by said trade process unit. (Page 23, line 8 through Page 24, line 1)
- b. Said advertisement distribution controller stores the transmitted advertisement data, and performs distribution of the store advertisement data, which is to be distributed on an advertisement opportunity, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 23: Roth discloses an advertisement opportunity trading method which enables communication between a terminal of a sponsor of an advertisement and a terminal of media which distributes an advertisement via a communication network, in order to intermediate between the sponsor and the media for facilitating a trade for an advertisement opportunity offered by the media, said method comprising:

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- a. Receiving advertisement data from a sponsor who wants the advertisement data to be distributed on an advertisement opportunity. (Page 6, line 17 through Page 7, line 15)
- b. Receiving an advertisement opportunity offered by media. (Page 6, line 17 through Page 7, line 15)
- c. Receiving information from the media representing that distribution of the advertisement data is appropriate/inappropriate when the sponsor selects the advertisement opportunity received in said receiving an advertisement opportunity for distributing the advertisement data received in said receiving advertisement data, and accepting an application for distribution of the advertisement data from the sponsor only after it is determined that the information from the media represents that distribution is appropriate. (Page 6, line 17 through Page 7, line 15)
- d. Performing a trading process for trading the advertisement opportunity based on the application accepted in said receiving information and accepting an application. (Page 6, line 17 through Page 7, line 15)

Claim 24: Roth discloses the advertisement opportunity trading method according to claim 23, wherein in a case where applications for distribution of advertisement data from a plurality of sponsors are accepted in said receiving information and accepting an application for a same advertisement opportunity, the



advertisement opportunity is put up for auction in said performing a trading process.

(Page 6, line 17 through Page 7, line 15)

Claim 25: Roth discloses the advertisement opportunity trading method according to claim 23, further comprising:

- a. Registering the advertisement data received in said receiving advertisement data. (Page 6, line 17 through Page 7, line 15)
- b. Registering the advertisement opportunity received in said receiving an advertisement opportunity. (Page 6, line 17 through Page 7, line 15)
- c. Publicizing information on the advertisement opportunity registered in said registering the advertisement opportunity via said communication network, wherein an application for distribution of the advertisement data registered in said registering the advertisement data is accepted from the sponsor in said receiving information and accepting an application. (Page 6, line 17 through Page 7, line 15)

Claim 26: Roth discloses the advertisement opportunity trading method according to claim 25, wherein:

- a. A plurality of advertisement data can be registered by a sponsor in said registering the advertisement data for one advertisement opportunity. (Page 23, line 8 through Page 24, line 1)

- b. In a case where the media determines that the plurality of advertisement data of the sponsor are appropriate for distribution on the one advertisement opportunity, an application for distribution of one advertisement data designated by the sponsor from the plurality of advertisement data is accepted as one to be actually distributed in said receiving information and accepting an application. (Page 23, line 8 through Page 24, line 1)

Claim 27: Roth discloses the advertisement opportunity trading method according to claim 26, wherein the advertisement data designated by the sponsor as one to be actually distributed is changed with another advertisement data among the plurality of advertisement data in accordance with an instruction from the sponsor in said receiving advertisement data. (Page 26, line 6 through Page 27, line 2)

Claim 28: Roth discloses the advertisement opportunity trading method according to claim 23, wherein:

- a. A genre of the advertisement data is received in said receiving advertisement data. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- b. A prohibited genre for designating a genre, which will not be distributed on the advertisement opportunity, is received in said receiving an advertisement opportunity. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- c. Said method further comprises checking whether the genre of the advertisement data distribution of which on the advertisement opportunity the sponsor applies

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for corresponds to the prohibited genre or not, and notifying a result of checking to the media. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)

Claim 29: Roth discloses the advertisement opportunity trading method according to claim 25, wherein:

- a. A genre of the advertisement data is registered in said registering the advertisement data. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- b. A prohibited genre for designating a genre, which will not be distributed on the advertisement opportunity, is registered in said registering the advertisement opportunity. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)
- c. Said method further comprises checking whether the genre of the advertisement data distribution of which on the advertisement opportunity the sponsor applies for corresponds to the prohibited genre or not, and notifying a result of checking to the media. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)

Claim 32: Roth discloses the advertising opportunity trading method according to claim 23, further comprising transmitting advertisement data which is determined as appropriate for distribution by the media to an advertisement distribution controller which performs distribution of advertisement data for mirroring purpose, wherein:

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- a. The advertisement data is transmitted to said advertisement distribution controller in said transmitting advertisement data before a trade for an advertisement opportunity is started in said performing a trading process. (Page 23, line 8 through Page 24, line 1)
- b. The advertisement data is stored in said advertisement distribution controller and is to be distributed on an advertisement opportunity by said advertisement distribution controller, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 33: Roth discloses the advertisement opportunity trading method according to claim 25, further comprising transmitting advertisement data, which is determined as appropriate for distribution by the media to an advertisement distribution controller for performing distribution of advertisement data for mirroring purpose, wherein:

- a. The advertisement data is transmitted to said advertisement distribution controller in said transmitting advertisement data before a trade for an advertisement opportunity is started in said performing a trading process. (Page 23, line 8 through Page 24, line 1)
- b. The advertisement data is stored in said advertisement distribution controller and is to be distributed on an advertisement opportunity by said advertisement distribution controller, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 34: Roth discloses a computer-readable recording medium, which stores a program for controlling a computer to function as:

- a. Advertisement data receiving means for receiving advertisement data from a sponsor who wants the advertisement data to be distributed on an advertisement opportunity. (Page 6, line 17 through Page 7, line 15)
- b. Advertisement data registering means for registering the advertisement data received by said advertisement data receiving means. (Page 6, line 17 through Page 7, line 15)
- c. Advertisement opportunity receiving means for receiving an advertisement opportunity offered by media. (Page 6, line 17 through Page 7, line 15)
- d. Advertisement opportunity registering means for registering the advertisement opportunity received by said advertisement opportunity receiving means. (Page 6, line 17 through Page 7, line 15)
- e. Advertisement opportunity publicizing means for publicizing information on the advertisement opportunity registered by said advertisement opportunity registering means via said communication network. (Page 6, line 17 through Page 7, line 15)
- f. Distribution accepting means for receiving information from the media representing that distribution of the advertisement data is appropriate/inappropriate when the sponsor selects the advertisement opportunity publicized by said advertisement opportunity publicizing means for

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distributing the advertisement data registered by said advertisement data registering means, and accepting an application for distribution of the advertisement data registered by said advertisement data registering means from the sponsor only after it is determined that the information from the media represents that distribution is appropriate. (Page 6, line 17 through Page 7, line 15)

- g. A trade processing means for performing a process for trading the advertisement opportunity based on the application accepted by said distribution accepting means. (Page 6, line 17 through Page 7, line 15)

Claim 35: Roth discloses the computer-readable recording medium according to claim 34, storing a program for controlling a computer to further function as advertisement data checking means for checking whether or not a genre of the advertisement data distribution of which on the advertisement opportunity the sponsor applies for corresponds to a prohibited genre which designates a genre which will not be distributed on the advertisement opportunity, and notifying a result of checking to the media. (Page 8, 1-11 and Page 19, line 27 through Page 20, line 26)

Claim 37: Roth discloses the computer-readable recording medium according to claim 34, storing a program for controlling a computer to further function as:

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- a. Advertisement data mirroring means for transmitting advertisement data, which is determined as appropriate for distribution by the media to advertisement distribution controlling means for performing distribution of advertisement data before a trade for an advertisement opportunity is started by said trade processing means. (Page 23, line 8 through Page 24, line 1)
- b. Advertisement distribution controlling means for storing the transmitted advertisement data and performing distribution of the stored advertisement data, which is to be distributed on an advertisement opportunity, in a case where a contract for the advertisement opportunity is settled. (Page 23, line 8 through Page 24, line 1)

Claim 38: Roth discloses an advertisement trading and distribution control apparatus, which provides information and an advertisement data to a terminal of an audience, said apparatus comprising:

- a. A trade process unit for performing a trading of an advertisement opportunity offered by a media in connection with advertisement data from a sponsor, said advertisement data to be distributed on the advertisement opportunity to the terminal of the audience. (Page 6, line 17 through Page 7, line 15)
- b. Distributing means for distributing the advertisement data to said terminal of an audience from a market control server, which intermediates between the sponsor of the advertisement data the media, which distributes the advertisement data to facilitate the trade for the advertisement opportunity, said distributing means

including a distribution acceptance unit for accepting an application for distribution of the advertisement data from the sponsor only after it is determined that the media approves the receipt of the advertisement data on the terminal of the audience. (Page 6, line 17 through Page 7, line 15)

- c. Storing means for receiving advertisement data to be provided to the terminal of the audience from said market control server, and storing the received advertisement data, wherein said distributing means starts distributing the advertisement data stored in said storing means to said terminal of an audience from a time set for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15)

Claim 39: Roth discloses an advertisement trading and distribution control method for providing information and an advertisement data to a terminal of an audience, said method comprising:

- a. Performing trading on a trade process unit for performing a trading of an advertisement opportunity offered by a media in connection with advertisement data from a sponsor, said advertisement data to be distributed on the advertisement opportunity to the terminal of the audience. (Page 6, line 17 through Page 7, line 15)
- b. Distributing the advertisement data to said terminal of an audience from a market control server, which intermediates between the sponsor of the advertisement data the media, which distribute the advertisement data to facilitate a trade for



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the advertisement opportunity, said distributing including a accepting an application for distribution of the advertisement data from the sponsor only after it is determined that the media approves the receipt of the advertisement data on the terminal of the audience. (Page 6, line 17 through Page 7, line 15)

- c. Receiving advertisement data to be provided to an audience from said market control server, and storing the received advertisement data, wherein distribution of the advertisement data is started from a time set for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15)

Claim 40: Roth discloses a computer-readable recording medium, which stores a program for controlling a computer to function as:

- a. A trade process unit for performing a trading of an advertisement opportunity offered by a media in connection with advertisement data from a sponsor, said advertisement data to be distributed on the advertisement opportunity to a terminal of an audience. (Page 6, line 17 through Page 7, line 15)
- b. Distributing means for distributing the advertisement data to the terminal of the audience from a market control server, which intermediates between the sponsor of the advertisement data and the media, which distributes the advertisement data to facilitate a trade for the advertisement opportunity, said distributing means including a distribution acceptance unit for accepting an application for distribution of the advertisement data from the sponsor only after it is determined

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that the media approves the receipt of the advertisement data on the terminal of the audience.. (Page 6, line 17 through Page 7, line 15)

- c. Storing means for storing the advertisement data. (Page 6, line 17 through Page 7, line 15)
- d. Distribution starting means for starting distribution of the advertisement data stored in said storing means to said terminal of the audience from a time set for the advertisement opportunity. (Page 6, line 17 through Page 7, line 15)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 9, 19, 20, 30, 31 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. (WO 98/34189).

Claims 8, 9, 19, 20, 30, 31 and 36: Roth discloses the advertisement opportunity trading system according to claims 1, 3 12, 14, 23, 25, and 34 respectively. In the teachings of Roth, an advertiser creates form objects when bids are proposed. The fields in these form objects contain limitations and restrictions the advertiser specifies regarding ad placement (Page 27, line 4 through Page 28, line 6). While, Roth does not explicitly disclose that these form objects are used to perform a

competition check, so that advertisements from the same business category are not displayed simultaneously, Official Notice is taken that it is old and well known that advertiser place restrictions upon media outlets regarding the placement of competitive advertisements. If Ford were to purchase advertising space on a web page, they would not want an adjacent advertisement from a competitor such as General Motors to be displayed on the web page. Displaying competitive advertisements in this manner erodes the effectiveness of both companies advertising campaigns. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate criteria allowing such restrictions. One would have been motivated to accommodate advertiser restrictions in order to generate wide scale acceptance and use of the automated bidding system and to help advertiser's maximize the effectiveness of their advertising budgets.

### ***Response to Arguments***

8. Applicant's arguments filed April 4, 2006 have been fully considered but they are not persuasive. The applicant argues that Roth does not disclose that the distribution accepting unit accepts the application for distribution of the advertisement only after it is determined that the information is appropriate to the media. The applicant states that the bidding selection logic in Roth does not receive any input from any source as to whether the advertising subject matter to be sent by the winning bid is appropriate and that such information is not supplied by the client

browser. However, The bidding agent (distribution accepting unit) in Roth performs these exact functions. Roth teaches that advertisers submit data through a bid input system to a central server which stores these advertisements and information regarding parameters that must be met, and the price the advertiser will pay for the advertisement to be displayed. When a viewing opportunity arises, the bidding agent (distribution accepting unit) evaluates the opportunity against the data submitted to the bid input system and determines whether or not a bid is appropriate. When a bid is determined to be appropriate, the bidding agent then sends the qualified advertisements to the bidding selection logic in order to determine the winning bid or bids. (Ross, Page 3, line 1 through Page 5, line 3)

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

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period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*JVB*  
JVB

  
ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3800